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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,115	07/18/2003	Michel John Arthur Groux	88265-6859	1635
29157 7590 01/08/2009 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER CHAWLA, JYOTI				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

### Office Action Summary

**Application No.**

10/622,115

**Applicant(s)**

GROUX ET AL.

**Examiner**

JYOTI CHAWLA

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-12 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1,3-12 and 14-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Applicant's submission filed on October 1, 2008 has been entered. Applicant has amended claims 1 and 12. Claims 1, 3-12, 14-17 are pending and examined in the application.

***Claim Rejections - 35 USC § 112 (First paragraph)***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Amendment to claims 1 and 12 dated 10/1/2008 adds "the milk product is room temperature microbial stable for at least one month and does not need to be cooled to provide the foamed composition,". As claimed the milk product is stable at room temperature for at least one month, however, applicant's disclosure (Specification Page 4, lines 19-26) states "On storage, the product remains stable for months without any visible sign of physical instability. It is possible with the product of the invention to reach an overrun of 5 about 300% (reached by using whipping tools) and the foam obtained remained stable for more than 2 hours at room temperature." Also Page 2, line 33 of the disclosure states that "the product is whippable and thick at room temperature" which also does not disclose the storage temperature of the product as claimed. Thus as claimed, the storage of product at room temperature has not been disclosed. Further, foam stability for 2 hours is not the same as product stability for at least one month, as instantly claimed. Furthermore, it is not clear as to what is included in the term "room temperature stable" as recited in the rejected claims. There is no recitation of "room temperature microbial stable for at least one month" in the original disclosure. Thus

claims 1, 3-12 and 14-17 include subject matter that was not disclosed in a way to enable one of skill at the time of the invention to make or use the product with the recited characteristics.

Claims 1 and 12 are further rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation of "the milk product is room temperature microbial stable for at least one month and does not need to be cooled to provide the foamed composition," also raises the issue of new matter as the microbial stability for one month has not been recited in the original disclosure as discussed above.

Claim 1 is further rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation of "the milk product for providing a room temperature both by shaking and with a foaming device," also raises the issue of enablement as the limitation of shaking and using a foaming device together as claimed has not been recited in the original disclosure as discussed above.

Applicants' response dated 10/1/2008 states that since the product is high temperature processed as claimed and "because one skilled in the art would know that room temperature microbial stability results from pasteurization, sterilization, UHT treatment and combinations thereof, Applicants respectfully submit that claims 1, 3-12 and 14-17 comply with the enablement requirement" (Remarks, pages 5 and 6, specially page 6, paragraph 2). Applicant's response has not been found convincing because all pasteurized or sterilized or UHT milk products are not stable at room temperature for at least one month as is instantly claimed, e.g., regular milk needs refrigeration even though it is pasteurized. Therefore applicant's argument is not convincing and the 112

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(first paragraph) enablement and new matter rejections are made for the reasons of record.

***Claim Rejections - 35 USC § 112 (Second paragraph)***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejection of claims 1, 3-12 and 14-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for the recitation of "the milk product is room temperature stable for at least one month and does not need to be cooled to provide the foamed composition," has been withdrawn based on applicant's amendment reciting "microbial stable". However the applicants are directed to the 112 (first paragraph) rejections above.

***Claim Rejections - 35 USC § 102/103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1) Claims 1, 5, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jonas (US 4,012,533).

References and rejections are incorporated herein and as cited in the office action dated June 2, 2008.

Regarding the amendments to claim 1, reciting "the milk product is room temperature microbial stable for at least one month and does not need to be cooled to provide the foamed composition," it is noted that Jonas teaches of high temperature processing as recited in the newly added limitation to claim 1. Jonas teaches a pasteurizing step in making the milk product (Column 9 and Column 11, line 40), i.e., high temperature processing to achieve microbial stability, as instantly claimed.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 3-4, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas in view of Gonsalves et al (U.S. 6,033,711).

Jonas has been applied to claims 1, 5, 8 and 10 and 11 above.

The references and rejection are incorporated herein and as cited in the previous office action mailed June 2, 2008.

(B) Claims 9 and 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas in view of Gonsalves further in view of Lynch (U.S. 5,759,609).

Jonas has been applied to claims 1, 5, 8 and 10 and 11 above. And Jonas in view of Gonsalves has been applied to claims 3-4 and 6-7 above.

The references and rejection are incorporated herein and as cited in the office action mailed June 2, 2008.

Regarding amended claim 12, Jonas discloses a method of forming a milk product comprising forming an emulsion containing sodium alginate as recited in claim 14, skim milk, carboxymethylcellulose, adding cream in water (Column 11 lines 27-45). Jonas

teaches a pasteurizing step in making the milk product that is microbially safe (Column 11 line 40) as instantly claimed.

(C) Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas in view of Gonsalves further in view of the combination of Lynch (U.S. 5,759,609) and Thompson (U.S. 3,230,091).

Jonas has been applied to claims 1, 5, 8 and 10 and 11 above. And Jonas in view of Gonsalves has been applied to claims 3-4 and 6-7 above.

The references and rejection are incorporated herein and as cited in the office action mailed June 2, 2008.

(D) Claims 1, 3-8, 10-11, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staackmann (US 3,519,440) in view of Gonsalves (U.S. 6,033,711).

The references and rejection are incorporated herein and as cited in the office action mailed June 2, 2008.

Regarding amendments to claim 1, Staackmann teaches a milk product that can be dispersed from spray can (i.e., aerosol container) that contains the milk product of claim 1 and is capable of dispensing the product as a stable white foam (Column 1, lines 68-72 and Column 2, lines 7-10). Staackmann Column 2, lines 5-10, where the reference teaches that the invention can be dispensed through a pressurized can, but does not state that the foamable composition can not be shaken to produce foam. Further, in Column 3, lines 15 and 16, Staackmann teaches light shaking of the foamable composition as well. Further it is known that foamable products, such as milk, whipping cream, etc., produce foam when shaken and it would have been obvious that the product foams upon shaking. Thus, Staackmann teaches foamable composition that can be shaken and foamed using a foaming device such as a pressurized can, as instantly claimed. The limitation of microbial safety and room temperature stability is taught by

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Staackmann in Columns 1 and 2 and Column 6, lines 5-11, as discussed in office action dated June 2, 2008.

### ***Response to Arguments***

Applicant's arguments filed October 1, 2008 have been fully considered but they have not been found persuasive.

I) Applicants remarks regarding Jonas not teaching the invention as recited have been fully considered but have not been found persuasive because Jonas teaches of a milk product comprising 0-15% fat (claimed range 0-40%), 3-10% protein (i.e., non-fat solids, claimed range 5-23%), which includes non-fat dry milk (Column 5, lines 17-25, Column 5, lines 59-61), at least two emulsifiers (Column 6, lines 30-33), a stabilizer and water as instantly claimed. Jonas teaches emulsifiers and combinations of emulsifiers including propylene glycol monostearate, mono and diglycerides, etc (Column 4, lines 22-34) and teaches that suitable stabilizers include alginates, carboxymethylcellulose, etc (Column 5, lines 2-6). Sodium alginate is utilized in a whipped milk based dessert as a stabilizer (Column 9, Table 1 and lines 45-46) as instantly claimed. Jonas teaches that the milk product does not exhibit syneresis or foam breakdown upon holding at room temperature for as long as 6 to 8 hours and exhibits the physical and organoleptic properties of whipped topping (Column 2, lines 60-65). Jonas also teaches of a pasteurizing step in making the milk product (Column 9 and Column 11, line 40), i.e., high temperature processing, as instantly claimed.

Regarding applicant's argument that "Jonas fails to disclose a milk product that is room temperature stable and does not need to be cooled to providing a foamed composition" (Remarks, Page 6, last 2 lines and page 8, paragraph 3). Regarding the limitation of unwhipped dessert or milk product being microbial stable at room temperature, Jonas teaches of a pasteurizing step in making the milk product (Column 9 and Column 11, line 40), i.e., high temperature processing that produces a microbially safe milk product, as instantly claimed.



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Regarding the room temperature stability, Jonas also teaches that it is desirable to maintain the temperature of the admixture of fat and protein emulsion above gelation temperature of gum stabilizers, i.e., above 40°F, in order to make a emulsion with syneresis resistance and freeze-thaw stability when whipped dessert is made (Column 8, line 17-40). Jonas further teaches of combining fat and protein as emulsion at approximately 60°F (i.e., room temperature) prior to whipping (Column 9, lines 50-55). Since room temperature falls above the gelation temperature of the gum stabilizers, Jonas teaches that the unwhipped product is room temperature stable as recited.

Regarding Jonas failing to teach "no need to be cooled to provide the foamed composition" Jonas teaches that it is essential that whipping is carried out above the freezing temperature of the mixture (Column 8, lines 15-25). Jonas further teaches of combining fat and protein as emulsion at 60°F (i.e., room temperature) which can serve as feed for whipping (Column 9, lines 50-55). Jonas also teaches that the unwhipped emulsion can either be sold as separate fat emulsion and protein emulsion or as mixed emulsion. Further Jonas teaches that the unwhipped emulsion can either be dry or liquid and is whipped in a suitable mixer by the consumer (Column 3, lines 11-28). Thus the product as taught by Jonas does not need to be cooled prior to providing a foamed or whipped composition, as applicants argue.

Further cooling is a relative term designating lowering of temperature and since the applicant has not specified the initial temperature or whipping temperature of the milk product of the invention, the cooling requirement as recited is relative, e.g., if the milk product is stored at room temperature and whipped also at room temperature, then there is no cooling required prior to making whipped product. Also if the product is stored at refrigeration or freezer temperature and whipped at either refrigeration or room temperature, there is no cooling required to whip the product. Thus, based on the above discussion, the milk product of Jonas does not need to be cooled prior to providing a foamed composition.

Regarding applicant's argument that the Jonas reference do not teach a product "that does not need to be cooled" it is noted that does not need to be cooled is not a positive

recitation that the product is not cooled prior to providing the foamed composition. As recited, the claim does not exclude cooling, however merely suggests a property of the composition and since Jonas teaches a milk based composition that falls in applicant's recited range, therefore, it would be obvious that the composition as taught by Jonas would have temperature stability and processing characteristics that are similar to the instantly claimed invention, absent any clear and convincing evidence and or arguments to the contrary.

**Note:** Applicant is further referred to rejection of claims 1 and 12 under 112 (first paragraph) made in the office action above.

II) In response to applicants' arguments against the references (Gonsalves, Lynch and Thompson) individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding Gonsalves and Lynch teaching away from the invention which is directed to a milk product (Remarks, page 8, paragraph 4), applicants are referred to Jonas who teaches of a milk product. Also Gonsalves includes milk fat (Column 2, lines 21-23) and milk proteins (Column 2, lines 58-63). Thus the reference does not exclude dairy products, as argued by the applicants. Further the reference is relied upon to teach a whipped product comprising 0.1 to 0.5% of gum stabilizers comprising a combination of microcrystalline cellulose and carboxymethylcellulose, alginates and mixtures thereof in order to provide structure to the foam (Column 3 lines 8-15) as instantly claimed. Therefore, it would have been obvious to one of ordinary skill in the art to modify Jonas and utilize a mixture of microcrystalline cellulose and carboxymethylcellulose as taught by Gonsalves in order to get a combination of stabilizers that works well together to provide sustainable structure to the foam of the milk product, i.e., in order to provide a more stable foam.

Gonsalves is also relied upon to teach that sorbitan tristearate as an emulsifier in a range from 0.03 to 0.19% (Column 2 lines 52-53) in a milk product such as whipped

topping. The reference also teaches that sorbitan tristearate is preferred in a milk product such as whipped topping because Sorbitan Tristearate acts as a fat crystal modifier in compound coatings and prevents crystal transformation and subsequent sandiness in spreads. Therefore, it would have been obvious to one of ordinary skill in the art to modify Jonas based on the teachings of Gonsalves by utilizing sorbitan tristearate as an emulsifier in order to provide a stable product with no fat crystal formation in the whipped composition.

Lynch is relied upon to show that emulsifiers, such as, propylene glycol monostearate (Column 5 lines 12-13), were known in the art of whipped toppings at the time of the invention (Jonas, Gonsalves and Lynch). It would have been obvious to one of ordinary skill in the art to modify Jonas based on the teachings from Lynch and Gonsalves and incorporate unsaturated monoglycerides and propylene glycol monostearate as emulsifiers, in order to provide a milk based whippable or foamable or whipped product that produces a stable foam when added to foods.

The process of addition of emulsifiers and stabilizers to foamable or whippable or whipped products was known at the time of the invention. The addition of same is not seen as a patentable distinction but merely an ingredient incorporated for its own art recognized contribution to the composition, for example, emulsifying fat in the composition and producing a stable foam. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated such ingredients as a matter of preference depending on, for example, availability, cost, desirable stiffness in the foam. New recipes for food involving the addition of common ingredients do not amount to invention merely because the coaction or cooperative relationship between the ingredients which produces new, unexpected, and useful function. In re Levin, 84 USPQ 232.

III) In response to applicant's argument that Staackmann does not teach the invention as claimed because Staackmann does not teach foaming with shaking "Staackmann requires its composition be under pressure in an aerosol to provide a foamed composition" (Remarks Page 9, paragraph 3). In response the applicant is

referred to Staackmann Column 2, lines 5-10, where the reference teaches that the invention can be dispensed through a pressurized can, but does not state that the foamable composition can not be shaken to produce foam. Further, applicants' are referred to Column 3, lines 15 and 16, teach light shaking of the foamable composition as well. Thus, applicants' arguments against Staackmann are not persuasive.

Therefore, applicant's arguments have been fully considered and have not been found persuasive and claims 1, 3-12, 14-17 have been rejected for the reasons of record.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JC/  
Examiner  
Art Unit 1794

/JENNIFER MCNEIL/  
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